

## REMARKS

This Response is being filed within three months of the non-final Office Action dated October 3, 2006.

Claims 1-12 and 20 are currently pending in this application. By this Amendment, claims 1 and 20 have been amended, and claims 3 and 11 have been canceled.

### Rejections Under 35 U.S.C. § 112

The Examiner has rejected claim 11 under 35 U.S.C. § 112, second paragraph for lack of proper antecedent basis. Claim 11 has been canceled, rendering the rejection moot.

### Rejections Under 35 U.S.C. § 102 and § 103

Claims 1, 4-6 and 12 have been rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,193,715 to Wrublewski (“Wrublewski”). Although applicant disagrees with the Examiner’s grounds for rejection, applicant has amended claim 1 to further distinguish over the cited reference.

In particular, claim 1 has been amended to specifically recite a plurality of fluid conduits that are “distinct and separate from the lumen”. In view of the fact that the Examiner has relied on the suction conduit of Wrublewski as satisfying the “fluid conduit” of original claim 1, applicants believe that the above amendment clarifying a lumen and fluid conduits that are separate and distinct from one another fully overcomes the Examiner’s rejection. Thus, as Wrublewski can no longer be said to disclose each and every element of amended claim 1, applicant believes that the rejection of claims 1, 4-6 and 12 is no longer proper, and respectfully requests reconsideration and withdrawal thereof.

Claims 1, 4-6 and 10-12 further stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,957,884 to Hooven (“Hooven”). Hooven similarly fails to teach or suggest a plurality of fluid conduits that are separate and distinct from the lumen, and thus fails to anticipate amended claim 1 for the reasons stated above in connection with Wrublewski. Reconsideration with respect to amended claim 1, and withdrawal of this rejection is also respectfully requested.

Claims 1, 3-6, 8, 10-12 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0055421 to West (“West”). Applicants

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respectfully disagree with the Examiner's rejection. Claims 1 and 20, as originally filed, recited an elongate shaft "having a lumen extending therethrough" and at least one active electrode "disposed about a periphery of the distal end of the shaft." West neither discloses nor suggests such features. There is no lumen extending *through* the device of West, as the distal end of element 60 appears to be closed entirely. Further, the active electrodes (66) of West are not located at the distal end of the shaft, but rather are positioned at a substantial distance from the distal end of the shaft in every instance.

Despite these deficiencies in West, amended claims 1 and 20 further recite that the lumen extending through the elongate shaft is "sized and shaped for insertion of a tissue grasper therethrough," and that the elongate shaft (on which the active electrode resides) "contains no moving parts". These elements are similarly missing from West. The device of West does not contain any lumen suitable for passing tissue or a tissue grasper through, nor does it contain an elongate shaft with no moving parts. As indicated at paragraph [0027] of the present application as published (US 2005/0070892), the ability to provide a morcellator that cuts and/or vaporizes tissue without requiring a rotating blade or other moving mechanical components is advantageous in vastly simplifying the production of such a device, as well as enabling a lighter and more reliable device. In view of the multiple elements recited in claims 1 and 20 that are missing from West, applicant respectfully submits that this reference cannot properly anticipate claims 1 or 20, or any claims that depend therefrom. Reconsideration and withdrawal is respectfully requested.

The remaining rejections include a rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over either Wrublewski, Hooven or West in further view of U.S. Patent No. 5,899,915 to Saadat ("Saadat"), and of claims 2 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Hooven in view of U.S. Patent No. 5,697,882 to Eggers et al ("Eggers"). Saadat discloses a traditional type morcellator that relies on a rotating tubular blade to cut through tissue. There is no disclosure in Saadat of fluid introduction, or of bipolar or any other electrosurgical features, let alone any of the features described above as lacking from Wrublewski, Hooven and/or West. Thus, applicant respectfully submits that the cited references, alone or in combination, fail to teach or suggest all elements currently present in amended claim 1 from which claim 7 depends.

With regard to the rejection of claims 2 and 9, as mentioned previously, amended claim 1 now recites a "lumen extending therethrough sized and shaped for insertion of a tissue grasper

therethrough” and further recites such a lumen “having a substantially uniform inner diameter.” These features are not taught nor suggested by the cited references. More particularly, the device disclosed by Eggers is not designed for use as a morcellator, where tissue is physically extracted through the central lumen with the aid of a tissue grasper that is inserted therethrough. This is particularly apparent from Col. 23, lines 35-40, where the device is described as having an overall diameter of 0.5 – 3 mm. Finally, amended claim 1 specifically recites a return electrode that has a “substantially annular configuration concentrically disposed about the shaft,” with such return electrode having a “plurality of recesses formed in said outer surface” which form the plurality of fluid conduits. No such structure is taught or suggested by Hooven or Eggers, or any other cited reference. Thus, applicant submits that the cited references cannot, alone or in combination, render the subject matter of amended independent claims 1 or 20 unpatentable.

In view of the foregoing amendments and discussion, applicant respectfully requests reconsideration and allowance of pending claims 1-2, 4-12 and 20.

Although no fee is believed to be due in connection with this Amendment, the Commissioner is hereby authorized to charge any such fee to deposit Account No. 10-0750/GYN-5003/MJS.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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